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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,580	07/15/2003	William R. Bidermann	PIX-P-036P1	8865
32566	7590	01/29/2004		
PATENT LAW GROUP LLP 2635 NORTH FIRST STREET SUITE 223 SAN JOSE, CA 95134				
			EXAMINER MAI, LAM T	
			ART UNIT 2819	PAPER NUMBER

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,580

Applicant(s)

BIDERMANN ET AL.

Examiner

LAM T MAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-10, 12, 14, 17-20, 23, 25, 27-29, 31, 33-34 is/are rejected.
- 7) ☒ Claim(s) 6-7, 11, 13, 15, 16, 21, 22, 24, 26, 30, 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Information Disclosure Statement

The information disclosure statement filed 7/15/2003 comply with 37 CFR 1.97, 1.98 and MPEP 609. They have been considered and placed in the application file.

Drawings

Figures 1, 2, 3, 4, and 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8-10, 12,14, 17, 18, 19, 20, 23, 25, 27, 28, 29, and 31 are rejected under the judicially created doctrine of double patenting over claims 1-17 of U. S. Patent No. 6,518,909 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an analog to digital converter for converting plurality of analog input signals to a plurality of corresponding digital values.

More, although the conflicting claims are not identical, they are not patentably distinct from each other because the patent 6,518,909 teaches essentially the same circuit as claims 1-5, 8-10, 12,14, 17, 18, 19, 20, 23, 25, 27, 28, 29, and 31 of the instant application. Even though claims are broadened by omitting certain limitations, it has been held that the omission of an element and its function is an obvious expedient if the remaining element perform the same function as before. In re Karlson, 136 USPQ 184(CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd App. 1969); omission of a reference element whose function is not needed would be an obvious variation.

This is an obviousness-type double patenting rejection.

Claims 1-5, 8-10, 12,14, 17, 18, 19, 20, 23, 25, 27, 28, 29, 31, and 33-34 are rejected under the judicially created doctrine of double patenting over claims 1-17 of U.

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S. Patent No. 6,310,571 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an analog to digital converter for converting plurality of analog input signals to a plurality of corresponding digital values.

More, although the conflicting claims are not identical, they are not patentably distinct from each other because the patent 6,518,909 teaches essentially the same circuit as claims 1-5, 8-10, 12, 14, 17, 18, 19, 20, 23, 25, 27, 28, 29, 31, and 33-34 of the instant application. Even though claims are broadened by omitting certain limitations, it has been held that the omission of an element and its function is an obvious expedient if the remaining element perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd App. 1969); omission of a reference element whose function is not needed would be an obvious variation.

This is an obviousness-type double patenting rejection.

Allowable Subject Matter

Claims 6-7, 11, 13, 15, 16, 21, 22, 24, 26, 30, and 32 are objected to as being dependent upon a rejected base claim, but they would be allowable considered for allowance if the above double patenting rejections are overcome by filing terminal disclaimer.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAM T MAI whose telephone number is (571)272-1807. The examiner can normally be reached on 6:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Tokar can be reached on (571) 272-1812. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Lam T. Mai
Art Unit 2819
January 24, 2004


PATRICK WAMSLEY
PRIMARY EXAMINER